

REMARKS

Reconsideration of this Application is requested.

The Examiner has objected to Applicants' submittal of a reissue declaration signed by the inventors, Bresnan and Oh. Applicants are submitting a Declaration signed by the assignee of the above identified application which states the patent claims less than the patentee had a right to claim, and that the assignee offers to surrender the original U.S. Patent No. 5,873,073 upon issuance of a Notice of Allowability on subject reissue Application.

The Examiner has objected to Applicants' broadening the claims by recapturing subject matter lost during the prosecution of the original patent. Applicants have amended the claims so as not to recapture subject matter, i.e., the use of only one printer, lost during the prosecution of the original patent. The claims have been amended to claim two printers in order not to claim subject matter that has been lost during the prosecution of the original patent application.

Claim 43 has been rejected by the Examiner for not conforming to the requirements of 37 C.F.R. §1.173 and 37 C.F.R. §1.121(b)(6). Applicants inadvertently neglected to underline added material in claim 43. The added matter in claim 43 is underlined in this amendment to conform to the above sections.

The Examiner has objected to the disclosure because of certain enumerated informalities. Applicants have amended the disclosure to correct the informalities mentioned by the Examiner.

The Examiner has objected to the subject matter of claims 23, 27 and 42 regarding the determining of postage from the entered characteristics. Support for the above appears in step 342 of Fig. 5B and on page 7, lines 5-7.

The Examiner has objected to the subject matter of claim 28 in regard to transmitting the address list and document data separately from the first node/processor to the terminal/second node processor. Support for the above appears in steps 106, 110, and 114 of Fig. 2 and on page 3, lines 57-65.

The Examiner has objected to claims 34 and 44 in regard to verifying the address list of the terminal/second node/processor. Support for the above appears in step 338 of Fig. 5B and page 6, lines 50-58.

The Examiner has objected to the specification under 35 U.S.C. §112 for failing to provide an adequate written description of the invention and for failing to support the invention as now claimed.

Support for claims 23, 27 and 42 appears in step 342 of Fig. 5B and on page 7, lines 5-7. Support for claim 28 appears in steps 106, 110, and 114 of Fig. 2 and on page 3, lines 57-65. Support for claims 34 and 44 appear in step 338 of Fig. 5B and page 6, lines 50-58.

Claims 23, 27, 28, 34, 42 and 44 have been rejected by the Examiner for the reasons set forth in the objection to the specification. For the reasons set forth above, the rejection of the claims under 35 U.S.C. §112 should be removed.

Claims 20, 23, 24, 27-34 and 42-47 have been rejected by the Examiner under 35 U.S.C. §112 for being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The Examiner is of the

opinion that the claims lack utility for the recited purpose of the disclosed and claimed invention, named the production of a finished mail piece. Applicants submit that, a mail piece does not have to be franked to be a finished mailpiece. The mail piece may be a permit mail mail piece.

Claims 1-46 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Cordery, et al (U.S. Patent No. 5,628,249) or Harman, et al. (U.S. Patent No. 5,684,706), or Baker, et al. (U.S. Patent No. 5,067,305) or Murcko, et al. (U.S. Patent No. 5,476,255) in view of Humes, et al. (U.S. Patent No. 5,377,120) and common practice.

Cordery discloses the following in column 1, line 64 to column 2, line 14:

“...an apparatus and method for producing a mail piece, wherein the apparatus includes a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and inserting the document into an envelope to form a mail piece. The mail finishing unit includes a second printer for printing an address on the envelope prior to insertion of the document into the envelope. The apparatus also includes a controller which is responsive to mail piece data; the mail piece data including first data for defining the document and second data for defining the address to be printed on the document. In accordance with the method of the subject invention the document is printed in the first printer and the envelope is printed with the corresponding address in the second printer prior to insertion of the document into the envelope and the printed document and printed envelope are fed along separate paths to an inserter where the document is inserted into the envelope.”

Harman discloses the following in column 1, line 66 to column 2, line 14:

“...a system including a plurality of apparatus for producing a mail piece, wherein the apparatus each include a first printer for printing a document and a mail finishing unit for receiving the document from the first printer and combining the document with an envelope to form a mail piece. The mail finishing unit includes a mechanism for franking the mail piece. The apparatus also includes a controller which is responsive to mail piece data; the mail piece data including first data for defining the document and second data for defining the address to be printed on the document and postal data defining a

postage value for the mail piece. The controller controls the first printer to print documents in accordance with the document data and controls the franking mechanism to frank the mail piece with the postage value."

Baker discloses the following in column 3, lines 1-16:

"...an apparatus which includes an input for input of information defining a mail piece configuration and sheet processing apparatus for accumulating sheets with an envelope form, folding the accumulated sheets and envelope form, and then sealing the envelope form to form the mail piece; where the folder sealer apparatus has a capacity to fold a predetermined maximum number of sheets. The apparatus of the subject invention also includes a control system for determining the number of sheets in the mail piece in accordance with the defining information and, if the number of sheets is less than the maximum, controlling the folder sealer apparatus in accordance with the defining information to form the mail piece in the configuration, and, if the number of sheets is greater than the maximum, aborting operation of the folder sealer apparatus without forming the mail piece."

Murcko discloses the following in column 3, lines 7-13

"...a means of a mechanism for feeding sheets from a stack which include a low force feed device for urging the top sheet of the stack forward, and a combined device for receiving the top sheet, corrugating the top sheet, singulating the top sheet from a following sheet which may have adhered to the top sheet and feeding the top sheet forward for further processing."

Humes discloses the following in column 2, lines 39-61:

"...a machine for lowering the mailing costs of small volume merchants by producing bundles for low postal rate mailings which are made up of the commingled pieces from a plurality of merchants. The machine comprises, in the preferred embodiment, a first computer operable to combine the mailing lists of a plurality of merchants and group the addresses on the mailing lists according to the lowers postal rate. The first computer is further operable to generate the address information required by postal regulations, such as bar codes or zip+4 numbers, for each address; and to further assign a merchant-identifier tag to each address thus creating a merged data base of the merchants' mailing lists. The first computer is further operable to generate documentation for the post office as well as individual client invoices. A second computer serves as a sequence controller to operate mail piece handling machinery according to the grouped addresses. The present

invention further comprises the mail piece handling machinery for physical commingling and addressing of the different merchants non-alike pieces.”

The art cited by the Examiner does not disclose or anticipate, separately or together, the method and system of defining and producing the finished mail piece claimed by Applicants. Applicants claim a method and system that allows a user to select at a first node a plurality of characteristics that define a mailing. Once the selections have been made, the selected information is transmitted to a terminal node, wherein the terminal node is not under the control of the first node so that the terminal node may control the time of production of mail pieces. The terminal node may also direct the production of mail pieces to mail production means for producing the mail. Hence, the mail piece may be directed to specific mail production means so that mail pieces may be produced efficiently or produced at a site that is closer to the recipient of the mail piece. Thus, the mail piece may be delivered in less time since it may be produced at a site and subsequently mailed from a site that is closer to the recipient.

The art cited by the Examiner in claim 1 and those claims dependent thereon, does not disclose or anticipate steps d, e, and h of claim 1, as amended, namely,

- (d) transmitting said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece, said mail production means further comprising:
 - (i) a first printer; and
 - (ii) a second printer;

Cordery, Harman, Baker, Murcko, or Humes, taken separately or together, do not disclose or anticipate claim 15 and those claims dependent thereon. The above references do not allow one to control the time for producing a mail piece at a mail production site that may be located close to the recipient of the mail piece to reduce the time for delivering the mail piece. Elements b, and c are not disclosed or anticipated by the above references:

(b) transmission means for transmitting said mailing to a second data processing means wherein said second data processing means is not co-located with, nor under the control of, said first data processing means;

(c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer;

Cordery, Harman, Baker, Murcko or Humes, taken separately or together, do not disclose or anticipate claim 20 , as amended, and those claims dependent thereon. The above references do not disclose or anticipate: selecting at a first node a plurality of characteristics which define a mailing; creating a document and storing said document in electronic form; creating an address list comprising one or more destination addresses and storing said address list in electronic form; transmitting said document, said address list and said characteristics to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node; receiving said document, said address list and said characteristics at said terminal node and directing said document, said address list and said characteristics to a mail production means; and inserting said printed document into a corresponding printed envelope to where said destination address information on said document matches said destination address on

said envelope if said document contains specific address information to form the mail piece.

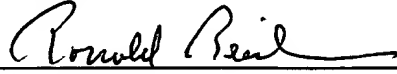
An advantage of Applicants' claimed invention over the cited art is that the cited art does not allow a terminal node that is not co-located with a first node that produces documents to control the production of documents that are going to be inserted into envelopes by a mail production means. This allows the mail pieces to be produced more efficiently, and the mail pieces may be produced at a site closer to the recipient to reduce the time required to deliver the mail.

Cordery, Harman, Baker, Murcko, or Humes, taken separately or together, do not disclose or anticipate claim 38, as amended, and those claims dependent thereon. They do not disclose or anticipate first data processing means for selecting a document and selecting destination addresses; a second data processing means for receiving the document, and the address wherein the second data processing means is not co-located with the first data processing means; and said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics, second means for printing each of said destination addresses to a corresponding envelope, and means for inserting said printed document into a corresponding printed envelope.

In view of the foregoing amendments and following remarks, it is respectfully submitted that claims 1-51 of this application are now in a condition for allowance and favorable action thereon is requested. If the Examiner has any questions, would he

please call the undersigned at the telephone number noted below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Ronald Reichman", is written over a horizontal line.

Ronald Reichman

Reg. No. 26,796

Attorney of Record

Telephone (203) 924-3854

PITNEY BOWES INC.
Intellectual Property and
Technology Law Department
35 Waterview Drive
P.O. Box 3000
Shelton, CT 06484-8000

Version with Markings to Show Changes Made

In the specification:

Page 1, second paragraph, line 18:

Reference is made to application Ser. No. 08/772,788, entitled A METHOD AND SYSTEM FOR WORLDWIDE MEDIA SELECTION, PRODUCTION, AND DELIVERY, assigned to the assignee of this application and filed on even date herewith and now U.S. Patent No. 5,918,220 issued June 29, 1999;

Page 1, third paragraph, lines 24 and 25:

Reference is made to application Ser. No. 08/772,790, entitled A METHOD AND SYSTEM OF ACCOUNTING FOR TRANSACTION COSTS AND CURRENCY EXCHANGE IN A HYBRID MAIL SYSTEM, assigned to the assignee of this application and filed on even date herewith [with a Notice of Allowance issued therefore on Jul. 21, 1998.] and now U.S. Patent No. 5,742,932 issued April 21, 1998.

Page 2, fourth full paragraph, line 42:

Once the document has been printed, the document is inserted into the envelope by inserting means to form an unfinished mail piece. The unfinished mail piece is sealed and then franked if it is not permit mail with appropriate postage in order to form a finished mail piece. The mail piece is then placed into a mail stream for delivery to the destination address. A receipt indicative of the print job and delivery into the mail stream may be optionally generated by the terminal node and transmitted to the first node. An

feature available is the use of postal coding and duplicate detection as applied to the address list.

Page 4, first full paragraph, line 15:

At step 118, the printed document is merged with the printed envelope to create an unfinished mailpiece. A number of different actions can be accomplished at this step. The printed media is manually or automatically inserted into the appropriate envelope, the envelopes can be stacked by stackers or redirected via transport means, weighed, and, the unfinished mailpiece can be sealed by a sealer if required. From step 118, the method advances to step 120 where the unfinished mailpiece is franked if it is not permit mail with appropriate postage by a postage meter and then placed into the mail stream at step 122.

Page 8, third full paragraph, lines 24-25 and lines 34-35:

Turning to FIG. 5D, there is shown a series of selections that can be made to further define the parameters of the requested mailing. The method flow begins with a query at step 376[;additionally, path]. The input to step 375 comes from C5 [coming from (FIG. 5C) re-enters the flow at step 376]. At step 376, the method queries as to whether or not the system operator wants to continue defining the mailing. If the response is "YES," then the method advances to step 386; otherwise, if the response to the query at step 376 is "NO," then the method advances to a query at step 378. At step 378, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 380

where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 378 is "YES," then the method advances to step 382 where the system user presses "DONE" to save the current entries. Both steps 380 and 382, advance to step 384 where the system returns the user to the Main Menu.

Page 9, first full paragraph, lines 7-8:

At step 404, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 406 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 404 is "YES," then the method advances to step 408 where the system user presses "DONE" to save the current entries. Both steps 406 and 408, advance to step 410 where the system returns the user to the Main Menu.

Page 10, third full paragraph, lines 46-47:

Returning to step 455, if the response to the query at step 455 is "NO," then the method advances to the query at step 457. At step 457, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 459 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data

entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 457 is "YES," then the method advances to step 461 where the system user presses "DONE" to save the current entries. Both steps 459 and 461, advance to step 463 where the system returns the user to the Main Menu.

Page 11, first paragraph, lines 4-5:

At step 487, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "YES," then the method advances to step 493 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 487 is "NO," then the method advances to the query at step 489. At step 489, the method queries as to whether or not the system operator wants to continue with the setup process. If the response is "YES," then the method advances to step 497 where the system operator presses "CONT" to save the entries made and advance to the Return Envelope Layout screen at step 499 before advancing along path C10 to step 501 as shown in FIG. 5I.

Page 11, fourth paragraph, lines 44-45:

Step 509 with a "YES" response and step 511 advance to the query at step 513. At step 513, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "YES," then the method advances to

step 519 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 513 is "NO," then the method advances to the query at step 515. At step 515, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances to step 523 where the system operator presses "CONT" to save the entries made and advance to the Outer Envelope Layout screen at step 525 before advancing along path C11 to step 527 as shown in FIG. 5J.

Page 12, first full paragraph, lines 20-21:

Step 535 with a "YES" response and step 537 advance to the query at step 539. At step 539, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "YES," then the method advances to step 545 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 539 is "NO," then the method advances to the query at step 541. At step 541, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances to step 549 where the system operator presses "CONT" to save the entries made and advance to the Second Outer Envelope Layout screen at step 551 before advancing along path C12 to step 553 as shown in FIG. 5K.

Page 12, fourth full paragraph, lines 55-56:

At step 569, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "YES," then the method advances to step 571 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 569 is "NO," then the method advances to the query at step 573. At step 573, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances to step 579 where the system operator presses "CONT" to save the entries made and advance along path C13 to step 581 as shown in FIG. 5L.

Page 13, fourth full paragraph, lines 45-46:

At step 603, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 609 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 603 is "YES," then the method advances to the query at step 605. At step 605, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances to step 613 where the system operator presses "CONT" to save the entries made and

advance to the Estimated Cost screen at step 615 before advancing along path C16b to step 637 as shown in FIG. 50.

Page 14, first full paragraph, lines 13-14:

At step 627, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 633 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of savings while the rest of the entered data will be retained within the system memory. If the response to the query at step 627 is "YES," then the method advances to the query at step 629. At step 629, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances to step 637 where the system operator presses "CONT" to save the entries made and advance to the Estimated Cost screen at step 639 before advancing along path C16c to step 637 as shown in FIG. 50.

Page 14, fifth full paragraph, lines 62-63:

At step 653, the method queries as to whether or not the system operator is done defining the mailing. If the response to the query is "NO," then the method advances to step 659 where the system user presses "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. If the response to the query at step 653 is "YES," then the method advances to the query at step 655. At

step 655, the method queries as to whether or not the system operator wishes to continue with the setup process. If the response is "YES," then the method advances along path C17 to step 663 as shown in FIG. 5P.

Page 15, fourth full paragraph, lines 43-44:

At step 683, if the response to the query is "YES," then the method advances to step 685 where the system user selects "CANCEL" and [any entries made in defining the mailing are not] erases only the data entered from the last point of saving while the rest of the entered data will be retained within the system memory. The method then returns the system user to the Main Menu at step 687. However, if the response to the query at step 683 is "NO," then the system user selects "BACK" at step 689 which returns the system user, at step 691, to the previous screen.

In the claims:

1. (Amended) A method of defining and producing a finished mail piece, comprising the steps of:

(a) selecting at a first node, a plurality of characteristics which together define a mailing;

(b) creating a document and storing said document in electronic form[:], then directing that said stored document be included in a print job comprising said mailing;

- (c) creating an address list comprising one or more destination addresses and storing said address list in electronic form and then selecting said stored address list for inclusion in said print job;
- (d) transmitting said print job to a terminal node wherein said terminal node is not co-located with, nor under the control of, said first node;
- (e) receiving said print job at said terminal node[:], said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece[:], said mail production means further comprising:
 - (i) a first printer; and
 - (ii) a second printer;
- (f) printing on said first printer said destination address to an envelope wherein each of said destination addresses is printed to a corresponding envelope;
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node;
- (h) inserting said printed document into said printed envelope to form an unfinished mail piece;

(i) sealing said unfinished mail piece;

(j) franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece; and

(k) placing said finished mail piece into a mail stream for delivery to said destination address printed thereon.

3. (Amended) The method of claim 1, wherein said each of said destination addresses comprising said stored address list is compared to a predetermined database of correct addresses wherein each address is matched with a corresponding zip code[;], and, if said each of said destination addresses does not match said correct address then said non-matching address is corrected to match said correct address.

18. (Amended) The system of claim 15, wherein said system further comprises a plurality of nodes wherein one node is an initiating node and a second node is a terminal node[;], and, if there are more than two nodes in said system, then said first and said second printer means are located at said terminal node.

38. (Amended) A system for producing a mail piece, comprising:

first data processing means for selecting a document, selecting an address list including one or more destination addresses, and selecting a plurality of characteristics which define a mailing;

second data processing means for receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means, wherein said second data processing means is not co-located with, nor under the control of, said first data processing means;

said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics, second means for printing each of said destination addresses to a corresponding envelope, and means for inserting said printed document into a corresponding printed envelope.

43. (Amended) A system according to claim 38, wherein said document and said address list are stored in electronic form.

Please add claims 48 through 51 as hereinabove noted.